



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/414,290	10/07/1999	JEFFERY M. ENRIGHT	D-1112R1	3095
28995	7590	05/01/2009		
RALPH E. JOCKE walker & jocke LPA 231 SOUTH BROADWAY MEDINA, OH 44256				
EXAMINER				
SCARITO, JOHN D				
ART UNIT		PAPER NUMBER		
3696				
MAIL DATE		DELIVERY MODE		
05/01/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/414,290

Applicant(s)

ENRIGHT ET AL.

Examiner

John D. Scarito

Art Unit

3696

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 January 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-43 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

The following is Examiner's response to Applicant's amendment received 01/15/2009 stemming from Examiner's Office Action dated 10/01/2008.

Status of the Claims

As per Applicant's response, Examiner acknowledges that Applicant amended Claims 1-15, 17-20, 22, 23, 26-34, & 36-40. Here, Claims 16, 21, 24, 25 & 35 are presented as originally filed, but are considered amended due to their dependence on amended claims. Claims 41-43 are previously presented. As such, Claims 1-43 are currently pending.

Note: Examiner is concerned about Applicant's pervasive use of "wherein" in his/her currently presented apparatus claims. In particular, apparatus claims cover what a device is, not what a device does. *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). Although features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997). **Here, a functional limitation becomes relevant only when it inherently imparts a structural limitation to accomplish the function recited.** In this vein, Examiner questions whether all of Applicant's wherein clauses inherently indicate further system structure, which must be given patentable weight or whether they are merely functional limitations which define what the apparatus does or a property or characteristic it has rather than by what

the apparatus is structurally. Here, unless Applicant's apparatuses are specifically configured to perform such functionalities, many wherein clauses will not be given patentable weight. Applicant may desire to alternatively use a method claim form. For purposes of this restriction, Examiner assumes that each wherein clause was intended to be accorded patentable weight.

Election/Restriction

Examiner requires Applicant election for further prosecution. Per 37 C.F.R. 1.142(a), "[s]uch requirement will normally be made before any action on the merits; however, it may be made at any time before final action." Further, MPEP 811 states "...the examiner should make a proper requirement as early as possible in the prosecution, in the first action if possible, otherwise, as soon as the need for a proper requirement develops." In particular, Applicant's extensive amendments to Claim 1 provoked Examiner's reconsideration of a restriction requirement.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-37, drawn to an apparatus comprising a machine including two different transaction function devices which operate independently to perform two different types of transactions wherein at least one camera captures images of machine users for a first type of transaction but prevents capture for a second type of transaction, said captured images displayed on a terminal browser, classified in class 902, subclass 6.

- II. Claims 38-40, drawn to an apparatus comprising an ATM including a plurality of function devices wherein operation of a particular function device causes at least one camera to store human image data corresponding to camera signals produced during a transaction while preventing storage of human image data associated with the operation of other function devices, said stored human image data displayed, on a time-shifted basis, on a terminal classified in class 348, subclass 143.
- III. Claims 41-43, drawn to an apparatus comprising and ATM including a plurality of transaction function devices wherein operation of a transaction function device, to carry out at least one ATM transaction function, causes at least one image device to store image data, said image data displayed, on a time-shifted basis, on a output device, classified in class 902, subclass 8 or class 705, subclass 43.

The inventions are distinct, each from the other because of the following reasons:

Inventions I, II & III are directed to related machines/apparatuses. Here, related inventions are distinct if: (1) the inventions as claimed are either not capable of use together **or** can have a materially different design, mode of operation, function, or effect; (2) the inventions do not overlap in scope, (i.e. each invention as claimed requires a mutually exclusive characteristic not required for the other invention); and (3) the inventions as claimed are not obvious variants. See MPEP § 806.05(j). In particular, Inventions I, II & III, the inventions as claimed can have a materially different design, mode of operation, function or effect.

As per Inventions I & II, Invention I requires that its two transaction function devices operate independently to perform two different types of transactions wherein a camera captures an image while Invention II requires a plurality of function devices (i.e. in lieu of transaction devices) wherein operation of a particular function device causes the storage of human image data (i.e. in lieu of an image). Furthermore, the inventions as claimed do not overlap in scope (i.e. Invention I requires user selectable transactions, a server, its computer in operative connection with the machine and a browser, while Invention II requires a cash dispenser device, date based storage, and its terminal in operative connection with the data store) and there is nothing of record to show them to be obvious variants (i.e. an apparatus must be distinguished based on structure).

As per Inventions II & III, Invention II requires a plurality of function devices wherein operation of a particular function device causes the storage of human image data but storage of human image data is prevented for the operation of other function devices, while Invention III requires a plurality of transaction function devices (i.e. in lieu of function devices) wherein operation of at least one transaction function device causes storage of image data (i.e. no prevention of the storage of image data). Furthermore, the inventions as claimed do not overlap in scope (i.e. Invention II requires a camera and a communication network in operative connection with the data store, while Invention III requires, an image device, a server and its computer in operative connection with the ATM) and there is nothing of record to show them to be obvious variants (i.e. an apparatus must be distinguished based on structure).

As per Inventions I & III, Invention I requires that its two transaction function devices operate independently to perform two different types of transactions wherein a camera captures

an image, while Invention III requires a plurality of transaction function devices (i.e. do not have to operate independently) wherein operation of at least one transaction function device causes storage of image data (i.e. in lieu of an image, no prevention regarding storage). Furthermore, the inventions as claimed do not overlap in scope (i.e. Invention I requires user selectable transactions, a camera, and a browser, while Invention III requires an image device) and there is nothing of record to show them to be obvious variants (i.e. an apparatus must be distinguished based on structure).

Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

- (a) the inventions have acquired a separate status in the art in view of their different classification;
- (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter; [i.e. storing an image, e.g. a picture versus storing image data, e.g. information about a picture]
- (c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries) [i.e. financial transactions versus ATM design versus surveillance systems] ;

(d) the prior art applicable to one invention would not likely be applicable to another invention; [capturing image data versus capturing images, continuous images versus snapshots, etc].

(e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected invention.

If claims are added after the election, applicant must indicate which of these claims are readable upon the elected invention.

Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John D. Scarito whose telephone number is (571) 270-3448. The examiner can normally be reached on M-Th (7:30-5:00), Alternate F (7:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Dixon can be reached on (571) 272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John D. Scarito/
Examiner, Art Unit 3696

/THOMAS A DIXON/
Supervisory Patent Examiner, Art Unit 3696